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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/522,434 | 03/09/2000 | Feng-Nien Ko | 11544-003001 | 3204 |

7590

01/24/2002

Eric L Prahl
Fish & Richardson PC
225 Franklin Street
Boston, MA 02110-2804

EXAMINER

COE, SUSAN D

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 01/24/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,434

Applicant(s)

KO ET AL.

Examiner

Susan Coe

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-9 and 11-22 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,7-9 and 12-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The amendment filed January 10, 2002 has been received and entered.
2. Claims 6 and 10 have been cancelled.
3. Claims 1, 3-5, 7-9, and 11-22 are currently pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2002 has been entered.

Election/Restrictions

4. In Paper No. 7, dated March 14, 2001, applicant's elected without traverse of Group, claims 1-11, and the extraction procedure of claim 3 (extraction with a solvent having a polarity higher than 0.88). In response to the Office action of August 28, 2001, applicant has effectively cancelled the elected species with the amendments to claim 1. Thus, in accordance with MPEP section 803.02, the new species selected for examination is the extraction procedure claimed in claim 1.
5. Claims 3-5, 7-9, and 12-22 are withdrawn from consideration as being drawn to non-elected invention and species.
6. Claims 1 and 11 are examined on the merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,795,742.

US '742 teaches administering ginsenosides to treat various health conditions. The ginsenosides are extracted from American ginseng using various solvents for extraction and by filtration of the extract (see column 7, Example 1). US '742 does not specifically teach that an ultrafiltration membrane with a molecular weight cut-off of 1,000 is used; however, the ginsenosides extracted have a molecular weight greater than 1,000 (see structural formula in column 3). Therefore, the composition extracted by US '742 appears to be the same as the claimed composition. US '742 does not teach that the ginsenosides treat ulcers; however, due to the fact that the composition of US '742 is the same as the claimed composition, the composition of US '742 would inherently have the same effects on the human body as the claimed composition.

8. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent English abstract of JP 04316507 A.

JP '507 teaches extracting American ginseng with water and methanol and then using ultrafiltration to exclude components with a molecular weight of less than 10,000. JP '507 does

not teach that the extract is able to treat ulcers; however, due to the fact that the composition of JP '507 appears to be the same as the claimed composition, the composition of JP '507 would inherently have the same effects on the human body as the claimed composition.

9. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by English abstract of JP 611097327 A.

JP '327 teaches extracting American ginseng with a water soluble solvent or water and then filtering the extract to obtain a component with a molecular weight of 100,000. JP '327 does not teach that the extract is able to treat ulcers; however, due to the fact that the composition of JP '327 appears to be the same as the claimed composition, the composition of JP '327 would inherently have the same effects on the human body as the claimed composition.

10. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (703) 306-5823. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

SDC
January 22, 2002


FRANCISCO PRATS
PRIMARY EXAMINER